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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05 CV 01114 JW **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S COMBINED REPLY MEMORANDUM IN SUPPORT OF ITS MOTION FOR RECONSIDERATION OF CERTAIN CLAIM CONSTRUCTION TERMS CONSTRUED BY THE COURT IN ITS THIRD CLAIM CONSTRUCTION ORDER AND ITS FOURTH CLAIM CONSTRUCTION ORDER** DATE: August 17, 2007 TIME: 1:00 p.m. CTRM: Hon. James Ware

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Acacia hereby submits its combined reply brief in support of its Motion for Reconsideration.

I. SUMMARY OF REPLY ARGUMENT

Transmission System and Receiving System: Defendants' claim construction argument concerning these terms is premised on a false fact – that the patentees acted as their own lexicographers in specially defining the terms "transmission system" and "receiving system" to refer, respectively, to one and only one transmission system (in Column 2 and Figures 2a and 2b) and to one and only one receiving system (in Columns 2-3 and Figure 6). This is demonstrably incorrect; the patentees disclosed and claimed multiple transmission system and receiving system inventions. Only by this Court giving those terms their ordinary meaning can this Court succeed in properly construing the multiple, different transmission system and receiving system inventions claimed in the asserted patents.

Sequence of Addressable Data Blocks: Defendants' contention that data block addressability can be achieved through means other than time encoding, and therefore that time encoding need not be in the claim construction for this term, ignores the fact that the specification only discloses time encoding and one of ordinary skill in the art at the time of the invention would not have understood, reading the Yurt patents, how to accomplish all the advantages and features of the different types of addressability achieved by time encoding without time encoding.

Storing: Unlike Acacia's proposal, Defendants request this Court to ignore the plain meaning of storing – which is placing or retaining (depending on context). This Court has previously recognized the applicability of this meaning to this term in these patents. For example, the Court construed the term "storing" as it is used elsewhere in claim 41 to mean "placing," but construed it to mean "holding" in claim 6 of the '992 patent. The first use of the word "storing" in claim 41, which precedes the "retrieving" step, refers to retaining or maintaining items immediately prior to retrieving the information in those items.

Defendants contend that the meaning of "storing" as "retaining" is "passive," and only "active" words can be used in a method step. Notwithstanding the fact that this is not the law, the term "retaining" is "an act or manipulative step," just as much as "placing," and even more than "permitting," which the *Landis* treatise, relied on by defendants, uses as a proper method step term.

II. THE COURT SHOULD RECONSIDER AND MODIFY ITS CONSTRUCTION FOR "TRANSMISSION SYSTEM" AND "RECEIVING SYSTEM"

Defendants contend that the Court's construction of "transmission system" and "receiving system" is correct, because the Court found that the patentees defined and disclosed one and only one transmission system and receiving system in the specification (depicted in Figures 2a and 2b), which the patentees described as the "invention." The Court's finding is demonstrably incorrect, notwithstanding defendants' arguments to the contrary. The intrinsic patent evidence demonstrates that the patentees described and depicted multiple transmission system and receiving system embodiments and claimed eighteen different transmission systems and claimed eleven different receiving systems in the originally-filed claims, each of which, as a matter of law, stands alone as a separate invention.

The intrinsic patent evidence therefore demonstrates that the patentees did not intend to give the terms "transmission system" and "receiving system" any special meaning or intend to disavow claim scope requiring the litany of interconnected "means" elements defined by the Court. The Court's constructions of these terms are therefore legally erroneous and require reconsideration.

A. As a Matter of Law, Each of Original Claims 1-18 Discloses Separate Transmission System Inventions and Each of Original Claims 22-32 Discloses Separate Receiving System Inventions

The Court based its construction of "transmission system" and "receiving system" on its finding that the patentees disclosed a single transmission system and receiving system invention. (See, 3rd CCO, at 7:19-27). This finding is incorrect as a matter of law, since it ignores the original claims of the '992 patent, which separately claim eighteen transmission system inventions (original claims 1-18) and eleven receiving system inventions (original claims 22-32). "Each claim must be considered as defining a separate invention." *Jones v. Hardy*, 727 F.2d 1524, 1528 (Fed. Cir. 1984); *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1220 (Fed. Cir. 1993) ("Each claim is a separate statement of the patent invention."); 35 U.S.C. § 282 ("Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of the other claims.”)[1]

Looking at the original claims alone, the patentees therefore did not disclose, nor could they have intended to disclose, a single transmission system or receiving system invention, as the Court incorrectly found. Thus, the case of *Modine Manufacturing Co. v. United States International Trade Comm.*, 75 F.3d 1545, 1551 (Fed. Cir. 1996), which applies to cases where a single embodiment is described as the invention itself (3rd CCO, at 7:23-27), is inapplicable to the facts of this case.

B. There is No Single, Definitional “Transmission System” or “Receiving System” Disclosed in the Specification; Rather the Patentees Disclosed Alternative Embodiments for Both the Transmission System and the Receiving System

1. The Patentees Used the Term “Transmission System” in the Specification to Refer to Multiple, Different Transmission Systems

a) In Figure 2a, the Patentees Disclosed Multiple Transmission Systems Which Operate With Analog and/or Digital Information and With Audio and/or Video Information

Defendants and the Court incorrectly contend and conclude, respectively, that Figures 2a and 2b depict a single transmission system and that this single transmission system is the only transmission system disclosed in the Yurt patents. Clear language in the specification identifies Figures 2a and 2b as depicting multiple, different transmission systems. The fact that the patentees used the term “transmission system” (and, as discussed below, “receiving system”) to generically describe multiple transmission system embodiments does not support the conclusion that the patentees intended to give the term “transmission system” a single, special meaning or any definition limited to any one embodiment. *See, e.g., Johnson Worldwide Assoc. v. Zebco Corp.*, 175 F.3d 985, 991 (Fed. Cir. 1999) (“Varied use of a disputed term in the written description demonstrates the breadth of the term rather than providing a limited definition.”)

The particular embodiment of the transmission system depicted in Figures 2a and 2b, relied on by the Court and the Defendants, is a transmission system which is capable of operating with both analog and digital material and with both audio and video material[2] (hereinafter "Transmission System 1"). Transmission System 1, however, is ***not*** the only embodiment of the transmission system depicted in Figures 2a and 2b and described in the patent specification. The patentees made clear in the specification that there is not one specific implementation of the transmission system depicted in Figures 2a and 2b. For example, the patentees twice described Figures 2a and 2b as "detailed block diagrams of preferred implementation***s*** of the transmission system of the present invention." ('992 patent, 3:28-30 and 5:59-61; emphasis added). The patentees also stated that a transmission system need not include all of the components of Figures 2a and 2b to be a transmission system: "[a] preferred embodiment of transmission system 100 may preferably include only some of the elements shown in FIGS. 2a and 2b."[3] ('992 patent, 5:63-65).

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[1] Although claims 1-18 and claims 22-32 each identify separate transmission and receiving system inventions, respectively, these claims do not identify “independant and distinct” inventions, which, pursuant to 35 U.S.C. Section 121, would have allowed the Patent Office to have used its administrative discretion to have issued a restriction requirement.

Thus, persons of ordinary skill in the art would have understood that Figures 2a and 2b depict a combination of structures from which multiple, distinct transmission systems could be fashioned, depending on the intended implementation for the system. For example, another implementation of a transmission system, in accordance with the patent, operates only with digital video input material (hereinafter "Transmission System 2"). Persons skilled in the art would know that Transmission System 2 does ***not*** require the analog input component of Figure 2a (127) or the audio-only components (123a, 114, 130, 128 and 117) of Figure 2a, but would require the digital input component (124) and the video-only components (123b, 114, 131, 129, and 117) of Figure 2a.

---

[2] Figure 2a includes analog and digital input receivers (127 and 124, respectively), audio and video converters ((123a/125a and 123b/125b, respectively), separate audio and video time encoders 114, audio and video precompression processors (115a and 115b, respectively), audio compressor and video compressor (128 and 129, respectively), and compressed data formatter 117.

[3] The fact that the patentees disclosed different transmission system embodiments depending upon the type and format of the information is reinforced by the original claims of the '992 patent, which are part of the specification. For example, original claim 1 of the '992 patent is silent as to the type and format of the input information, meaning that claim 1 covers both analog/digital and audio/video. Dependent claims 3, 4, 5, 9, and 10, add limitations which specifically describe the format and type of the input information, and, based on the input information, define which structures are required. (*See, e.g.*, claim 3 – "wherein the information in the items includes analog signals" and requiring converting means for analog-to-digital conversion and formatting means for converting digital information to formatted data. Claim 3 therefore would not cover a digital-only transmission system).

Transmission System 2 (digital video only) is depicted in the grey portions of Figure 2a below:

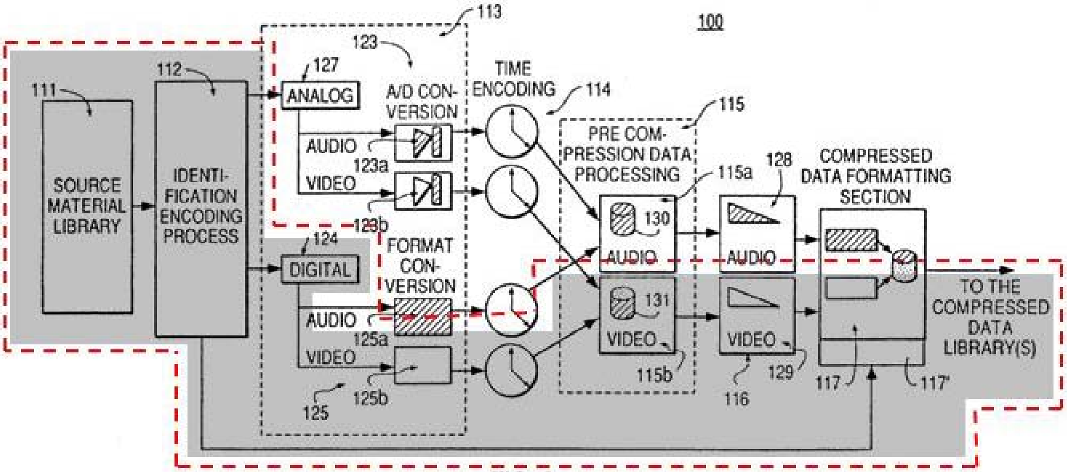

113
100
123
127
112
111
ANALOG
A/D CON-
VERSION
TIME
ENCODING
114
115
AUDIO
VIDEO
123a
PRE COM-
PRESSION DATA
PROCESSING
115a
128
COMPRESSED
DATA FORMATTING
SECTION
SOURCE
MATERIAL
LIBRARY
IDENTI-
FICATION
ENCODING
PROCESS
130
AUDIO
AUDIO
123b
124
DIGITAL
FORMAT
CON-
VERSION
131
VIDEO
VIDEO
TO THE
COMPRESSED
DATA
LIBRARY(S)
AUDIO
125a
VIDEO
125b
125
115b
129
116
117
117'

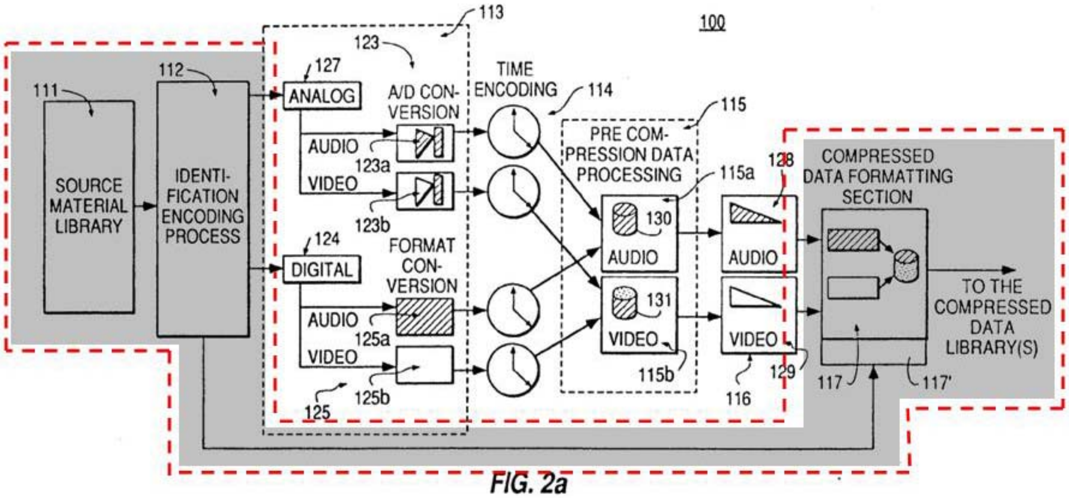
FIG. 2a

b) In Figure 2a, the Patentees Disclosed Transmission Systems Which Do and Do Not Accept Inter-Library Transfers of Already-Compressed Items

From prior Markman hearings, the Court is already familiar with the fact that Figure 2a includes a line from the “identification encoding process 112” to the “compressed data formatting section 117” and is familiar with the fact that this line represents the pathway taken by incoming inter-library transfer materials. (See, ‘992 patent, 7:44-50). Inter-library transfers are optional. (*Id.*) Because these transferred materials have been previously compressed, they do not require any conversion, time encoding, or compression; they can be sent directly from the identification encoder to the compressed data formatter 117’ and then to the compressed data library 118. (See, Figure 2a). If necessary, these materials are stored in short term storage 117’ in the compressed data formatting section. (‘992 patent, 7:55-58).

Thus, persons of ordinary skill in the art would have understood that Figures 2a and 2b depict additional, alternative transmission system embodiments – (1) those which receive and transmit only inter-library transfer materials (and therefore none of the converting, time encoding, and compression components are needed or included) and (2) those which receive and transmit no inter-library transfer materials (and therefore the line in Figure 2a, from the identification encoding process to the compressed data formatting section is not included). These alternative transmission system embodiments are depicted in Figure 2a:

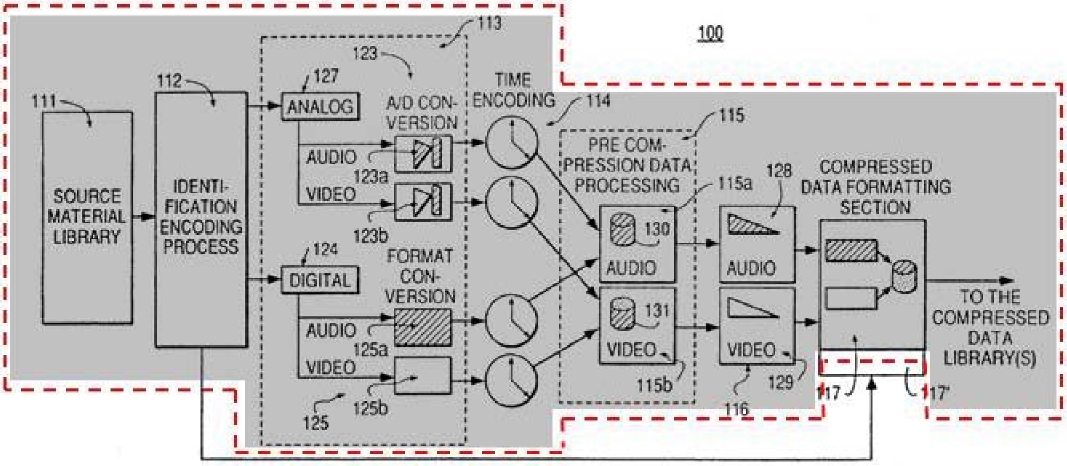
Inter-Library Transfer-Only Transmission System



100
113
123
127
ANALOG
A/D CON-
VERSION
TIME
ENCODING
114
115
111
112
SOURCE
MATERIAL
LIBRARY
IDENTI-
FICATION
ENCODING
PROCESS
AUDIO
VIDEO
123a
123b
PRE COM-
PRESSION DATA
PROCESSING
115a
128
COMPRESSED
DATA FORMATTING
SECTION
130
131
124
DIGITAL
FORMAT
CON-
VERSION
125a
125b
125
TO THE
COMPRESSED
DATA
LIBRARY(S)
115b
116
129
117
117'

FIG. 2a

No Inter-Library Transfers Transmission System[4]



100
113
123
127
ANALOG
A/D CON-
VERSION
TIME
ENCODING
114
115
111
112
SOURCE
MATERIAL
LIBRARY
IDENTI-
FICATION
ENCODING
PROCESS
AUDIO
VIDEO
123a
123b
PRE COM-
PRESSION DATA
PROCESSING
115a
128
COMPRESSED
DATA FORMATTING
SECTION
130
131
124
DIGITAL
FORMAT
CON-
VERSION
125a
125b
125
TO THE
COMPRESSED
DATA
LIBRARY(S)
115b
116
129
117
117'

FIG. 2a

[4] The specific embodiment of the "no inter-library transfers transmission system" depicted above is for a system intended to be implemented with both analog and digital information and with both audio and video information. Of course, other implementations are possible for a "no inter-library transfer transmission" with respect to the type of information (analog and/or digital and audio and/or video).

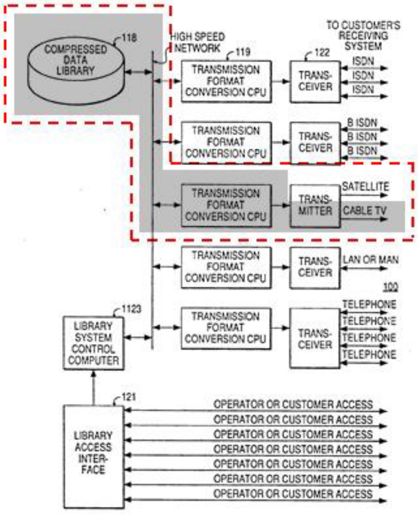
c) In Figure 2b, the Patentees Disclosed Multiple Transmission System Embodiments for Different Types of Transmission

Figure 2b depicts four transceivers and one transmitter for ISDN, B ISDN, satellite, cable TV, LAN or MAN, and telephone. Nowhere does the specification state that ***all*** of these transceivers and the transmitter are required in the "transmission system." Indeed, the patentees described an alternative transmission system which is a cable television system ('992 patent, 4:37-51 and Figure 1f). Cable television systems only require a cable television transmitter as the transmitting component. None of the other transceivers or transmitters depicted in Figure 2b would be included in a cable television system.

This disclosure, together with the disclosure that the transmission systems may include only some of the elements shown in Figures 2a and 2b ('992 patent, 5:63-65), would lead a person of ordinary skill in the art to understand that a transmission system in accordance with the invention would not be required to include every one of the transceivers and transmitters shown in Figure 2b, but it need only have at least one of them. For example, a cable television system would only require a cable television transmitter. Similarly, a satellite broadcast system would only require a satellite transmitter. Thus, Figure 2b depicts multiple transmission systems depending on the type of transmission to be implemented.

Figure 2b depicts a cable television transmission system:

Cable Television Transmission System



COMPRESSED DATA LIBRARY
118
HIGH SPEED NETWORK
119
TRANSMISSION FORMAT CONVERSION CPU
122
TRANS-CEIVER
TRANS-MITTER
TO CUSTOMER'S RECEIVING SYSTEM
ISDN
ISDN
ISDN
B ISDN
B ISDN
B ISDN
SATELLITE
CABLE TV
LAN OR MAN
100
TELEPHONE
TELEPHONE
TELEPHONE
TELEPHONE
1123
LIBRARY SYSTEM CONTROL COMPUTER
121
LIBRARY ACCESS INTER-FACE
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS

FIG. 2b

d) The Precompression Processor is Not Part of the Compression Means

In its opening brief, Acacia pointed out that the summary description of "transmission system" at 2:26-48 ("Column 2") is different than the transmission systems depicted in Figures 2a and 2b because Figure 2a depicts a "precompression processor 115," but the Column 2 system does not. In response, the Round 3 defendants contend that the precompression processor 115 is included in Column 2 as part of the "compression means," based on Dr. Walters' interpretation of the meaning of the "compression means" in Column 2.

From the intrinsic patent documents, however, it is clear that the patentees did not intend that the compression means must include the precompression processor. Dr. Walters ignores original claim 1, which includes a "compression means" and ignores original claim 8, which depends from claim 1 and adds the limitation that the transmission system of claim 1 further includes a precompression data processing means coupled to the ordering means. Thus, the compression means of claim 1 cannot include the precompression data processing means (i.e., the precompression processor) of claim 8, because, if it did, it would render claim 8 meaningless.[5] In fact, in this separate transmission system embodiment of dependent claim 8, the precompression data processing means, not the compression means, is coupled to the ordering means, which is another difference between the Column 2 embodiment, claim 8, and Figures 2a and 2b.[6]

Further, this is not the first time that the issue of the construction of the term "compression means" has arisen. In the context of claim 7 of the '720 patent, which included a "compression means for compressing the formatted data," the Round 2 satellite defendants stipulated with Acacia that the "compression means" is construed as compressor 116 and its equivalents. (Stipulation re Terms from the '863 and '720 Patents, July 21, 2006, Document No. 187, at 4). The parties did not include the precompression processor as part of the compression means.[7]

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[5] *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) ("the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim."); *Rambus, Inc. v. Infineon Technologies AG*, 318 F.3d 1081, 1093 (Fed. Cir. 2003) ("The district court's construction would render claim language in dependent claims 27 and 28 meaningless. This court disfavors such a construction").

[6] Dr. Walters' testimony is extrinsic evidence which contradicts the language of claims 1 and 8. The Court should therefore give no weight to Dr. Walters' extrinsic evidence. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996) ("extrinsic evidence in general, and expert testimony in particular, may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language. . . Indeed, where the patent documents are unambiguous, expert testimony regarding the meaning of a claim is entitled to no weight.")

e) The Transmission Format Conversion CPU is not Part of the Transmitter Means

Another difference between the Column 2 transmission system embodiment and Figures 2a and 2b embodiments highlighted by Acacia in its opening brief is the transmission format conversion CPU, which is present in Figure 2b, but is not described in Column 2. The Round 3 defendants again rely on Dr. Walters to contend that the transmitter means of Column 2 should be interpreted to include the transmission format conversion CPU.

As with the compression means above, the original claims, ignored by Dr. Walters, demonstrate that the patentees did not intend that the transmitter means would include the transmission format conversion CPU. Original claim 1 includes a transmitter means. Original claim 2 depends from claim 1 and adds the limitation that the transmitter means further includes a transmission format means. Thus, the transmitter means cannot include the transmission format means (i.e., the transmission format conversion CPU).[8] *Phillips,* 415 F.3d at 1315; *Rambus,* 318 F.3d at 1093.

Also, as with the compression means above, the issue of the construction of "transmitter means" has previously arisen. In the context of claim 7 of the '720 patent, which included a

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[7] Even if, as the Round 3 defendants further contend, based on Dr. Walters' declaration, a transmission system that does not include a "precompression processor" would be inoperable and therefore is not available as a possible alternative transmission system embodiment, these alternative transmission system embodiments are specified in patent claims, and the law is clear that "claims need not recite every component necessary to enable operation of a working device." *Rambus*, 318 F.3d at 1093.

[8] Again, the Round 3 defendants rely on the extrinsic expert testimony of Dr. Walters. Dr. Walters contradicts the language of claims 1 and 2. Again, the Court should give no weight to Dr. Walters' extrinsic evidence. *Vitronics*, 90 F.3d at 1584.

"transmitter means" for "transmitting a representation of the at least one item at a real-time rate to at least one of a plurality of subscriber selectable receiving stations," the Round 2 satellite defendants contended that the "transmitter means" is construed as "transceiver/transmitter 122 in Figure 2b." This construction does not include the transmission format conversion CPU as part of the transmitter means. (Joint Claim Chart re Claims from the '863 and '720 Patents, July 21, 2006, Document No. 186, at 11).[9]

2. The Patentees Used the Term "Receiving System" in the Specification to Refer to Multiple, Different Receiving Systems

a) Figure 6 Depicts Multiple Receiving Systems

Defendants and the Court incorrectly contend and conclude, respectively, that the patentees disclosed a single receiving system in Columns 2 and 3 of the summary section of the patents and in Figure 6. Just as Figures 2a and 2b depict multiple transmission systems, Figure 6 depicts multiple receiving systems.

As discussed above, the specification teaches that the input information may comprise audio and/or video information, meaning that the receiving system receives audio and/or video information: "The reception system 200 includes transceiver 201 which receives the audio and/or video information transmitted by the transmitter 122 of the transmission system 100." ('992 patent, 18:3-6).

Figure 6 depicts a data formatter 204, which separates the received information into audio and video information for decompression by separate video and audio decompressors. Thus, the particular embodiment of the receiving system of Figure 6, relied on by the Court and the defendants, depicts a receiving system which is capable of operating with both audio and video information. But, persons skilled in the art, knowing that the receiving system could operate with audio or video information, or both, would understand that Figure 6 actually depicts three receiving systems, one which is intended to receive both audio and video material (the embodiment relied on by the Court and the defendants), one which is intended to receive only audio information, and one which is only intended to receive video information:[10]

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[9] Another distinction between Figures 2a and 2b and the summary description of transmission system in Column 2 is the library system control computer and library access interface, which are depicted in Figure 2b, but which are not described in Column 2. Additionally, claim 1 does not include the library system control computer or the library access interface; these components are added in means form to the claim 1 transmission system in dependant claim 7.

Receiving System for Receiving Only Audio Information

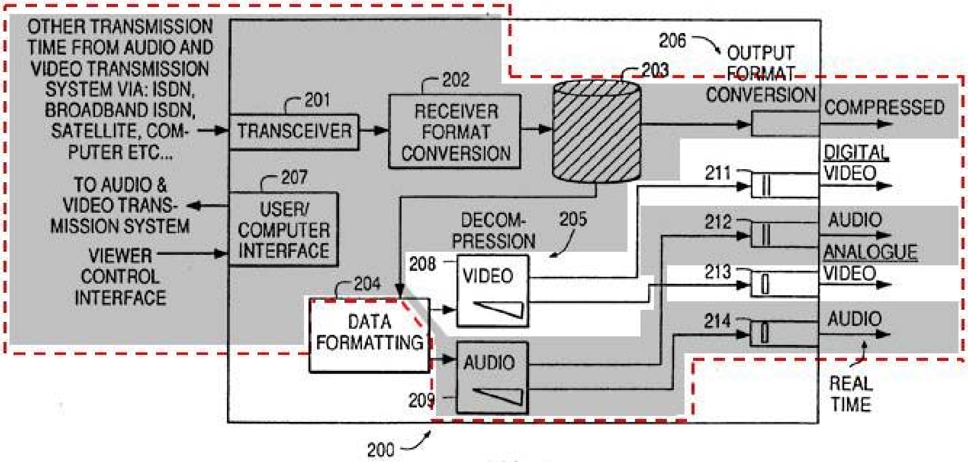
OTHER TRANSMISSION TIME FROM AUDIO AND VIDEO TRANSMISSION SYSTEM VIA: ISDN, BROADBAND ISDN, SATELLITE, COMPUTER ETC...
TO AUDIO & VIDEO TRANSMISSION SYSTEM
VIEWER CONTROL INTERFACE
201
TRANSCEIVER
202
RECEIVER FORMAT CONVERSION
203
206
OUTPUT FORMAT CONVERSION
207
USER/ COMPUTER INTERFACE
DECOMPRESSION
205
208
VIDEO
204
DATA FORMATTING
AUDIO
209
COMPRESSED
211
DIGITAL VIDEO
212
AUDIO
213
ANALOGUE VIDEO
214
AUDIO
REAL TIME
200

FIG. 6

Receiving System for Receiving Only Video Information

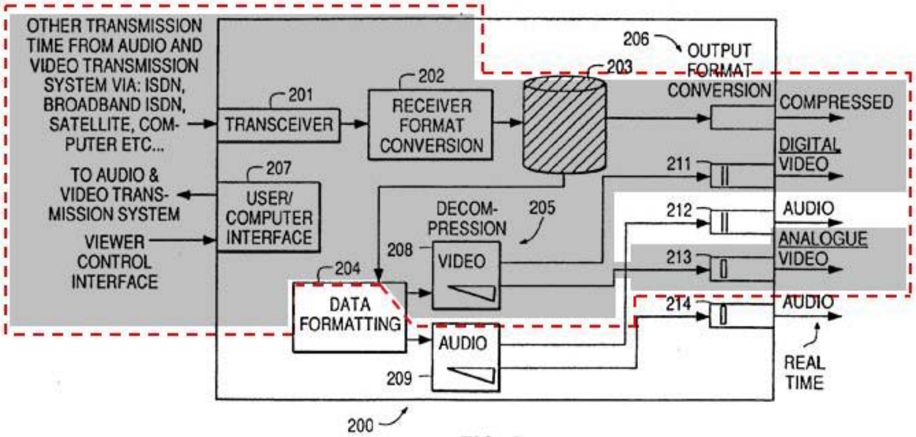
OTHER TRANSMISSION TIME FROM AUDIO AND VIDEO TRANSMISSION SYSTEM VIA: ISDN, BROADBAND ISDN, SATELLITE, COMPUTER ETC...
TO AUDIO & VIDEO TRANSMISSION SYSTEM
VIEWER CONTROL INTERFACE
201
TRANSCEIVER
202
RECEIVER FORMAT CONVERSION
203
206
OUTPUT FORMAT CONVERSION
207
USER/ COMPUTER INTERFACE
DECOMPRESSION
205
208
VIDEO
204
DATA FORMATTING
AUDIO
209
COMPRESSED
211
DIGITAL VIDEO
212
AUDIO
213
ANALOGUE VIDEO
214
AUDIO
REAL TIME
200

FIG. 6

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[10] The fact that the specification discloses different receiving system embodiments, depending upon the type of information received, is reinforced by the original claims of the '992 patent. For example, claim 22 is an independent claim, which does not specify whether the information received is audio, video or both, thereby meaning that claim 22 covers audio, video, or both. In addition, claim 22 does not include a data formatter and does not specify separate decompressors for audio and video or separate output converters for audio and video. Dependent claim 26 adds the limitation that the decompression means further includes video signal decompression means (thereby eliminating receiving systems having only audio components). See also, dependent claims 27, 29, 30, and 31.

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b) The Specification Teaches that the User Interface Need Not Be Included in the Receiving System

In its opening brief, Acacia pointed out that the summary description of the "receiving system" at 2:62 – 3:14 ("Columns 2-3") is not the same as the receiving system depicted in Figure 6 and described in claim 23, because Figure 6 and claim 23 require a "user interface." (Figure 6 includes a "user/computer interface 207" and original claim 23 requires a "user interface means"). Thus, the summary description in Columns 2-3 describes one embodiment for a receiving system (one without a user interface) and Figure 6 and claim 23 describe another embodiment for a receiving system (one with a user interface).[11]

Defendants dismiss this clear difference by contending that these are not different embodiments, but rather that the "user interface" is an "add-on" to a single embodiment, i.e., invention.[12] This is absurd – a receiving system having no user interface could infringe claim 22 (because no user interface is required), but it could ***not*** infringe claim 23 (because claim 23 requires a user interface). This fact demonstrates that a receiving system with a user interface is different than a receiving system without a user interface.

3. The Court's Construction Improperly Excludes Alternative Transmission System Embodiments and Receiving System Embodiments Disclosed and Depicted in the Patent Specification

The Court's current construction for "transmission system" and "receiving system," if retained, would exclude from the patent claim coverage inventions that are both claimed and described in the specification. This would be clear error. The Court's current construction of the those terms require the inclusion of all of the components depicted in Figures 2a and 2b, including all of the analog and digital components, the video and audio components, and of the transceivers/transmitters,[13] i.e., every component depicted in Figures 2a and 2b[14] and Figure 6.[15] Correspondingly, the Court's construction would ***not*** cover the transmission systems and receiving systems, which do not contain all of the components for audio and video information (and analog and digital information) or all of the possible transceivers/transmitters.

---

[11] Another difference between Columns 2-3 and figure 6 is the presence of the data formatter, which is not described in Columns 2-3, but is shown in Figure 6.

[12] Defendants appear to be confused about the "user interface." They concede that the user interface is not part of the Court's definition of "receiving system," but they contend that the Court's construction is depicted in Figure 6.

The following are examples of transmission and receiving systems which are disclosed in the specification and are within the scope of the claims, but which are excluded from the Court's current construction:

- Analog-only transmission systems (i.e., no digital components included);
- Digital-only transmission systems (i.e., no analog components included);
- Audio-only transmission systems and receiving systems (i.e., no video components included);
- Video-only transmission systems and receiving systems (i.e., no audio components included);
- Inter-library transfer-only transmission systems (i.e., no conversion, time encoding, or compression components included); and
- Cable television-only transmission systems (i.e., only the cable transmitter included).

The Court's claim constructions therefore are ***contrary*** to the patentees' intended scope for the "transmission system" and "receiving system," as set forth in the specification. There is no evidence that the patentees intended to disavow these embodiments from the claims; indeed, there is no prosecution history showing that the patentees were forced to limit the scope of the meaning of "transmission system" in order to overcome prior art.

---

[13] In its construction, the Court specifically refers to the "transmitter means (as illustrated in the block diagram labeled Figure 2b)." (3rd CCO, at 8:23-24). Figure 2b illustrates four transceivers and one transmitter. It therefore appears that the Court is requiring the "transmission system" to include every transceiver/transmitter in Figure 2a.

[14] The Court's construction for "transmission system" is unclear as to whether the "library system control computer 1123" and the "library access interface 121" depicted in Figure 2b are included. Although these components are depicted in Figure 2b, they are not structures for performing the functions of the recited means elements in the Court's construction.

[15] The Court's construction for "receiving system" is unclear as to whether the "user interface" depicted in Figure 6 is included. Although the "user interface" is depicted in Figure 6, it is not a structure for performing any of the functions of the recited means elements in the Court's construction.

Instead, the specification makes clear that the patentees intended to include these embodiments in the claims. (*See*, '992 patent, 5:63-65: "[a] preferred embodiment of transmission system 100 may preferably include only some of the elements shown in FIGS. 2a and 2b."). *See*, *Vitronics*, 90 F.3d at 1583-84, *quoting*, *Hoescht Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1581 (Fed. Cir. 1996) ("We share the district court's view that it is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment, or that persons of skill in this field would read the specification in such a way.")

C. The Patentees Are Not Required to Claim Every Component of the Transmission and Receiving Systems Disclosed in the Specification; Additional Claim Language Sets Forth Which Structures or Functions Are Being Claimed

The Round 3 defendants contend that, "even if the plain meaning of transmission system was broader than . . . the use of the term in the specification, the Court's construction would still be correct, because the Court's construction captures the broader conception of transmission system that the patentees had and disclosed . . ." (Round 3 Def.'s Opposition, at p. 18). The Round 3 defendants incorrectly presume that the patentees are required to claim every element or feature described in the specification. Here, the patentees have claimed certain transmission systems and receiving systems, but in no claim do the patentees specifically require a "transmission system" or a "receiving system" in which all of the structures or functions described in the specification are required.[16] Because the patentees are free to claim transmission systems and receiving systems comprising less than all of the structures and functions described in the specification, the Court's construction is improper. It is perfectly permissible to claim a portion of a transmission system or a portion of a receiving system, without claiming each and every structure or function of such system

[16] For example, claim 1 of the '992 patent, which defendants contend includes all of the limitations of the Court's construction for transmission system, does not, for example, require the library system control computer or the library access interface, both of which are depicted in Figure 2b. Similarly, claim 25 of the '992 patent (original claim 22) does not require the user interface or data formatter of Figure 6.

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disclosed in the specification. *See, Rambus*, 318 F.3d at 1093 ("[t]here is no requirement that every claim recite every component necessary to enable operation of a working device."). "When the claim addresses only some of the features disclosed in the specification, it is improper to limit the claim to other, unclaimed features." *Ventana Medical Systems, Inc. v. Biogenex Laboratories, Inc.*, 473 F.3d 1173, 1181 (Fed. Cir. 2006), *citing, Phillips*, 415 F.3d at 1327. It is error for the Court to construe the terms "transmission system" and "receiving system" to require every structure and/or function in the specification. *SRI Int'l. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*) ("'[T]hat claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims.' [citation omitted]. If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment.")

Thus, persons skilled in the art would look to each claim[17] to determine which particular features and/or functions are required for the particular "transmission system" and/or "receiving system" in that claim.[18] *See, Phillips,* 415 F.3d at 1312, *quoting, Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004) ("It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.'"). The following claim terms are exemplary of this point.

---

[17] The Court's construction for the terms "transmission system" and "receiving system" applies to ***all*** of the claims of the Yurt family of patents in which it appears. In construing terms contained in the '863 and '720 patents, the Court held that the term "transmission system" had the same meaning that the Court gave it with respect to claims 19 and 41 of the '992 patent. (See, 4th CCO, at 6:19-21 and 20:16-17). *See also, Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed. Cir. 2003) ("[W]e presume unless otherwise compelled, that the same claim term in the same patent or related patents carries the same construed meaning."); *Nazomi Communications, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1370 (Fed. Cir. 2005) ("If a claim term appears in more than one claim it should be construed the same in each.") (citation omitted).

[18] With respect to the terms "receiving system" and "reception system," as used in claim 19 of the '992 patent and claims 2 and 5 of the '275 patent, Acacia previously contended that those terms are construed to include the functions of the those systems set forth in the claims themselves. Otherwise, the meaning of these terms is the same: "an assembly of elements.

1. Claim 1 of the '992 Patent

In claim 1 of the '992 patent, the patentees defined the elements of the transmission system in the ***body*** of the claim, ***not*** in the meaning of the term "transmission system." Claim 1 uses the term "transmission system" in its preamble. When applying the ordinary meaning for "transmission system" to the language of claim 1 [in brackets],[19] the identity of the structures which are required to be present in the "transmission system" would be clear to persons skilled in the art, just as the patentees had intended:

> A **transmission system** [assembly of elements capable of functioning together to transmit signal waves] for providing information to be transmitted to remote locations, the **transmission system** [assembly of elements capable of functioning together to transmit signal waves] comprising:
>
> library means for storing items containing information; identification encoding means for retrieving the information in the items from the library means and for assigning a unique identification code to the retrieved information;
>
> conversion means, coupled to the identification encoding means, for placing the retrieved information into a predetermined format as formatted data;
>
> ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks;
>
> compression means, coupled to the ordering means, for compressing the formatted and sequenced data blocks;
>
> compressed data storing means, coupled to the data compression means, for storing as files the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means; and
>
> transmitter means, coupled to the compressed data storing means, for sending at least a portion of one of the files to one of the remote locations.

With the Court's construction for "transmission system," however, there would be unnecessary redundancy and inconsistencies between the Court's construction for "transmission system" in the preamble and the elements in the body of the claim. The patentees could not have reasonably intended for claim 1 to include these redundancies and inconsistencies, as shown below:

---

[19] The ordinary meaning to persons of ordinary skill in the art for "transmission system" is set forth in the *IEEE Dictionary*: "An assembly of elements capable of functioning together to transmit signal waves." (Weiss Decl., ¶ 13). The ordinary meaning to persons of ordinary skill in the art for "receiving system" is the inverse: "An assembly of elements capable of receiving transmitted signal waves." (Weiss Decl., ¶ 15).

> 1. A **transmission system** [An apparatus which comprises the following interconnected components: a source material library means, an identification encoding means, a conversion means, an ordering means, a compression means, a compressed data storing means (as illustrated in the block diagram labeled Figure 2a), and a compressed data storage means and a transmitter means (as illustrated in the block diagram labeled Figure 2b). The corresponding structure for each means is the structure identified in the specification for performing the recited function] for providing information to be transmitted to remote locations, the **transmission system** [An apparatus which comprises the following interconnected components: a source material library means, an identification encoding means, a conversion means, an ordering means, a compression means, a compressed data storing means (as illustrated in the block diagram labeled Figure 2a), and a compressed data storage means and a transmitter means (as illustrated in the block diagram labeled Figure 2b). The corresponding structure for each means is the structure identified in the specification for performing the recited function] comprising:
>
> library means for storing items containing information; identification encoding means for retrieving the information in the items from the library means and for assigning a unique identification code to the retrieved information;
>
> conversion means, coupled to the identification encoding means, for placing the retrieved information into a predetermined format as formatted data;
>
> ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks;
>
> compression means, coupled to the ordering means, for compressing the formatted and sequenced data blocks;
>
> compressed data storing means, coupled to the data compression means, for storing as files the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means; and
>
> transmitter means, coupled to the compressed data storing means, for sending at least a portion of one of the files to one of the remote locations.

2. Claim 41 of the '992 Patent

Claim 41 of the '992 patent also uses the term "transmission system" in its preamble. Claim 41, unlike claim 1, does not specify the structures of the transmission system. However, claim 41 does define some of the functions required to be performed by the transmission system. The structures for performing these functions are described in the specification, not in the claim.

Applying the ordinary meaning of the term "transmission system" in claim 41 would be consistent with the patentees' intent that claim 41 describe the functions for the transmission system, but not limit the transmission system to any specific structure(s).

Even though claim 41 does not specify the structures for the "transmission system," by specifying the required functions for the transmission system, persons skilled in the art would be able to determine whether any particular system is infringing, because to infringe, the transmission system would have to perform all of the functions in the claim:

> 41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a **transmission system** [assembly of elements capable of functioning together to transmit signal waves], of:
>
> storing items having information in a source material library;
>
> retrieving the information in the items from the source material library;
>
> assigning a unique identification code to the retrieved information;
>
> placing the retrieved information into a predetermined format as formatted data;
>
> placing the formatted data into a sequence of addressable data blocks;
>
> compressing the formatted and sequenced data blocks;
>
> storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
>
> sending at least a portion of the file to one of the remote locations.

If the Court's construction were applied to claim 41, however, the patentees' intent to claim the functions, but not the structure, of the transmission system would have been eviscerated. There is no evidence that the patentees intended the term transmission system in claim 41 to have the meaning set forth by the Court:

> 41. A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a **transmission system** [An apparatus which comprises the following interconnected components: a source material library means, an identification encoding means, a conversion means, an ordering means, a compression means, a compressed data storing means (as illustrated in the block diagram labeled Figure 2a), and a compressed data storage means and a transmitter means (as illustrated in the block diagram labeled Figure 2b). The corresponding structure for each means is the structure identified in the specification for performing the recited function], of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a unique identification code to the retrieved information;

placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a sequence of addressable data blocks;

compressing the formatted and sequenced data blocks;

storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and

sending at least a portion of the file to one of the remote locations.

3. Claim 1 of the '702 Patent

Claim 1 of the '702 patent uses both terms "transmission system" and "receiving system," but claim 1 of the '702 patent does not claim all of the structures of the terms "transmission system" and "receiving system" present in the Court's construction or described in the specification. In other words, applying the Court's construction of these terms to claim 1 of the '702 patent adds limitations to the claims that the patentees never intended to include in the claim. The Court's claim construction therefore violates the rule that "[w]hen the claim addresses only some of the features disclosed in the specification, it is improper to limit the claim to other, unclaimed features." *Ventana Medical Systems*, 473 F.3d at 1181.

Claim 1 of the '702 patent claims a "transmission system" comprising: (1) a sequence encoder; (2) an identification encoder; and (3) a compressed data library. Claim 1 also claims a "reception system" comprising: (1) a transceiver; (2) a storage device; (3) user playback controls; (4) a digital decompressor; and (5) a playback device.

If the Court's construction for "transmission system" and "reception system" is applied to claim 1, the meaning of these terms in claim 1 would be changed. The transmission system in claim 1 would comprise: (1) a source material library means; (2) an identification encoding means; (3) a conversion means; (4) an ordering means; (5) a compression means; (6) a compressed data storing means; (7) a compressed data storage means; and (8) a transmitter means. The Court's construction therefore ***adds*** limitations to the transmission system of claim 1 that are not present in claim 1, such as the source material library means, the conversion means, the compression means, and the transmitter means.[20] Additionally, for limitations that are present in claim 1, the Court's construction changes the scope of those limitations, e.g., compare "compressed data storing means" and "compressed data storage means" of the Court's construction to "compressed data library" of claim 1.[21]

The "reception system"[22] in claim 1 would comprise: (1) a transceiver means; (2) a receiver format conversion means; (3) storage means; (4) decompressing means; and (5) output data conversion means. The Court's construction therefore ***adds*** limitations to the reception system of claim 1 that are not in claim 1, such as the receiver format conversion means and the output data conversion means. Additionally, for limitations that are present in claim 1, the Court's construction changes the scope of those limitations, e.g., compare "decompression means" of the Court's construction (presumably requiring both audio and video decompressors) to "decompressor" of claim 1 (which is not limited to audio or video or both).[23]

---

[20] The fact that the Court's construction for "transmission system" adds limitations to claim 1 shows that the Court's construction for "transmission system" is narrower than the patentee's "broadest conceptions" and "broadest invention" that they had or contemplated. (See, Round 3 Def.'s Opposition, at 18:1-3). Patentees are legally permitted to claim a system that does not recite every component necessary to enable operation of a working device. *See, Rambus*, 318 F.3d at 1093.

[21] The Court's construction requires a "compressed data ***storing*** means (as illustrated in the block diagram labeled Figure 2a)." There is nothing illustrated in Figure 2a that is identified as a "compressed data ***storing*** means." The only reference in the specification to a "compressed data storing means" is found in column 2:41-42 (which does not specify and component of Figure 2a) and in some of the claims (e.g., '992 patent, claim 1). The Court also includes a "compressed data ***storage*** means" in its construction. In the specification, the "compressed data ***storage*** means" is identified as reference number 117 in Figure 2a, i.e., the compressed data formatting section. Thus, the Court has excluded the compressed data library 118 from its construction, as the compressed data library 118 is depicted in Figure 2b.

[22] The Court has stated that the term "reception system" is given the same meaning as "receiving system." (3rd CCO, at 10:4-5: "In light of the specification, the Court finds that the phrases 'receiving system' and 'reception system' should be given common definitions.")

[23] This same is true for independent claims 17 and 27 of the '702 patent, independent claim 1 of the '720 patent, independent claim 1 of the '863 patent, independent claims 1, 4, and 7 of the '275 patent, and independent claims 1 and 47 of the '992 patent.

Thus, with respect to "transmission system" and "receiving system" in claim 1 of the '702 patent, the Court has improperly limited the claim to include unclaimed features.

D. The Court's Construction Is Further Improper, Because It Would Make Dependent Claims Superfluous

Another claim construction rule violated by the Court's construction is the doctrine of claim differentiation, which states that there is a presumption that each claim in a patent has a different scope. *Phillips*, 415 F.3d at 1315. Thus, a claim construction that would render a dependent claim meaningless or superfluous would be improper. *Phillips*, 415 F.3d at 1315; *Rambus*, 318 F.3d at 1093.

With respect to "transmission system," claim 2 of the '702 patent adds the limitation to the "transmission system" that the transmission system includes a "source material library." But, when applying the Court's construction to claim 1, the transmission system is already construed to include a "source material library means." Without the Court's construction, claim 1 does not require a source material library (or a source material library means) and therefore claim 2 is not superfluous or redundant of claim 1. Thus, the Court's construction for "transmission system" renders claim 2 superfluous and redundant of claim 1, in violation of the doctrine of claim differentiation.

With respect to "reception system," claim 11 of the '702 patent adds the limitation to the "reception system" that the reception system includes a receiver format converter. But, when applying the Court's construction to claim 1, the reception system is already construed to include a "receiver format conversion means." Without the Court's construction, claim 1 does not claim a receiver format converter (or a receiver format conversion means) and therefore claim 11 is not superfluous or redundant of claim 1.

Thus, the Court's construction for "reception system" renders claim 11 superfluous and redundant of claim 1, in violation of the doctrine of claim differentiation.[24]

---

[24] The same is true for dependent claims 3, 4, 5, 8, 28, 29, 30, 31, 32, and 34 of the '702 patent with respect to "transmission system" and for dependent claims 12, 37, and 38 of the '702 patent with respect to "reception system."

E. The Ordinary Meaning of the Terms "Transmission System" and "Receiving System" Includes Components Incident to Transmission and Reception.

The Round 3 defendants contend that the Court's construction is correct, because the patentees defined the terms "transmission system" and "receiving system" in the specification to mean the systems depicted in Columns 2-3 and in Figures 2a, 2b, and 6, and the patentees' definition for these terms is contrary to their ordinary meaning to persons of skill in the art. The entire premise of defendants' argument – that one of ordinary skill in the art would narrowly understand a transmission system to be nothing more than a transmitter and a reception system to be nothing more than a receiver – is wrong. As demonstrated above, the patentees used these terms to generally describe multiple embodiments and inventions; the patentees did ***not*** define these terms. *See, Johnson Worldwide*, 175 F.3d at 991 ("Varied use of disputed term in the written description demonstrates the breadth of the term rather than providing a limited definition.")

The term "transmission system" has an ***extremely broad*** ordinary meaning. Persons of ordinary skill in the art would have understood that "transmission system" is not limited to any specific structure, such as a transmitter, as the definitions relied on by Dr. Walters make clear:

- ". . . a transmission system is a complex aggregate of electronic gear and the associated medium, which together provide a multiplicity of channels over which many customers' messages and associated control signals can be transmitted . . ." (Bell Laboratories, *Transmission Systems for Communications* (5th Ed. 1982).

- ". . . Present-day transmission systems range in complexity from simple unamplified audio-frequency lines to satellite radiocommunication systems." (J. E. Flood & P. Cochrane, *Transmission Systems*, (1991).

- "***Part of a communication system*** organized to accomplish the transfer of information from one point to one or more points by means of signals." (*Telecom Glossary 2000* (2001)).

- "***An assembly of elements*** capable of functioning together to transmit signal waves." (*IEEE Dictionary*.)[25]

These definitions are broad enough to cover the transmission systems described in the patent

[25] Dr. Walters' opinion that a "transmission system" must "prepare the information for real-time transmission (i.e., the information is transmitted immediately after it is prepared for transmission)" is not supported in any of these definitions, as none refer to "real-time" transmission or place limits on when the information is transmitted (Walters' Decl., at ¶ 16).

specification, as the elements set forth in the patent are not explicitly excluded from these definitions, and they do act together to accomplish the transmission of information that is variously stored, retrieved, compressed and processed (this is the sole purpose of the system).

Dr. Walters further states that, in his opinion, "those of ordinary skill in the art would understand that the term 'transmission system' as used in the specification of the '992, '275, '863, and '702 patent means ***the system*** which is depicted in figures 2a and 2b, and does not refer to the plain meaning of 'transmission system.'" (Walters' Decl., at ¶ 28; emphasis added). Dr. Walters' opinion is based on an erroneous assumption, namely that there is only one transmission system depicted in Figures 2a and 2b. Dr. Walters makes the same erroneous assumption with respect to "receiving system" by assuming that there is only one "receiving system" depicted in Figure 6. (Walters' Decl., at ¶ 30.)

The Court should not give any weight to Dr. Walters' testimony. *Vitronics*, 90 F.3d at 1585.

F. The Claims of the Yurt Patents Are Not Indefinite When The Ordinary Meanings for "Transmission System" and "Receiving System" Are Applied to Each Claim

Defendants contend that, if the terms "transmission system" and "receiving system" are given the meanings proposed by Acacia, then they would be indefinite. In other words, defendants contend that the *IEEE Dictionary* definition for "transmission system" is indefinite.

Defendants do not actually apply the ordinary meaning of "transmission system" or "receiving system" to any claim; instead, defendants discuss indefiniteness of these terms in the abstract. This is improper, as indefiniteness requires an examination of what is claimed in light of the specification: "In ruling on a claim of patent indefiniteness, a court must determine whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Bancorp Serv., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004).

To the extent that the defendants are contending that the *IEEE Dictionary* definition for "transmission system" is overly broad, this is not a grounds for indefiniteness. *Smithkline Beechham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1341 (Fed. Cir. 2005) ("the test for indefiniteness does not depend on a potential infringer's ability to ascertain the nature of its own accused product to determine infringement, but instead on whether the claim delineates to a skilled artisan the bounds of the invention.". . . "breadth is not indefiniteness.")

The Court should also consider the fact that the Round 1 defendants, who now contend that the *IEEE Dictionary* definition is indefinite, previously asked the Court to construe "transmission system" to have the ordinary meaning from the *IEEE Dictionary*, stating that the *IEEE Dictionary* definition is consistent with the use of "transmission system" in the claims, written description, and prosecution history of the '702 patent. (*See*, Round 1 Defendants' Responsive Claim Construction Brief Regarding United States Patent No. 6,144,702, May 13, 2004 at 2:16-5:15; Block Supp. Decl. Exhibit 4.)

G. No Defendant Addresses Acacia's Contention that the Court Erred by Construing the Term "Transmission System" as a Means-Plus-Function Term Pursuant to 35 U.S.C. § 112, ¶ 6

In its opening brief, Acacia addressed the Court's holding that claim 19 is limited to the transmission system and receiving system disclosed in the specification, because, according to the Court, "a method claim containing a preamble which requires that the steps be performed by an apparatus, is limited to that apparatus and any other apparatus identified in the specification for performing the specified step." (3rd CCO, at 7:15-17).

Acacia pointed out that this holding was erroneous, because the Court was, in effect, construing the term "transmission system" as a means-plus-function term, but in both claims 19 and 41 of the '992 patent, the terms "means" or "means for" are not used. Thus, the presumption, which cannot be overcome, is that the patentees did not intend that the term "transmission system" be construed as a means-plus-function term, and therefore application by the Court of Section 112, ¶ 6 to "transmission system" would be improper.

***No defendant has addressed this portion of Acacia's opening brief*.**[26] We can therefore presume that defendants agree with Acacia that the Court's application of Section 112, ¶ 6 to "transmission system" is improper.

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[26] The Round 3 defendants address a different issue. They contend that Acacia "criticizes the Court for using 'means' language in the definition of 'transmission system.'" (Round 3 Def.'s Opposition, at 20:22-23). Although that was not Acacia's contention, Acacia does believe that it is improper to construe a non-means term, such as "transmission system" and "receiving system," with

III. THE COURT SHOULD RECONSIDER AND MODIFY ITS CONSTRUCTION OF "SEQUENCE OF ADDRESSABLE DATA BLOCKS"

Only the Round 3 defendants address Acacia's request for reconsideration of "sequence of addressable data blocks." Thus, we may presume that the Rounds 1 and 2 defendants, who have not opposed this portion of Acacia's motion for reconsideration, agree with Acacia's proposed modifications to the Court's construction for "sequence of addressable data blocks."

A. The Term "Addressable" Is Used In the Patent With Respect to the Phrase "Sequence of Addressable Data Blocks" To Require Time Encoding

In their Opposition, the Round 3 defendants state that: "[t]he patentees never equate addressability with time codes or in any way define, implicitly or explicitly, addressability to require time encoding." (Round 3 Def's Opp. at 30:6-8). Based on this contention, the Round 3 defendants contend that term "addressable" in the phrase "sequence of addressable data blocks" is used in the patent consistent with its ordinary meaning, i.e., that "addressable" refers to physical storage locations. Defendants ignore the fact that the Court specifically rejected the ordinary meaning of "addressable" in its construction: "[a]ddressable does not refer to physical storage locations, but rather to positions relative to the beginning of a file containing information." (3rd CCO, p. 31).

The Round 3 defendants' Opposition statement is unusual for another reason; their statement is exactly opposite to what the Round 3 defendants stated in their August 11, 2006 Markman Brief. In their Markman Brief, the Round 3 defendants instructed the Court that the Yurt patents make clear that time encoding is the addressing scheme for data blocks and that the patent teaches that both the starting position for the file and time encoding are required for addressing the data blocks:[27]

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means elements (which, in the Court's construction, do not include any recited functions) as this will cause juror confusion as to the application of means elements to the structures in the specification. Acacia does not propose removing the "means" language, as defendants propose; instead, Acacia proposes the Court adopt its proposed construction.

[27] The Round 3 defendants do not address or distinguish their own prior Markman Brief statements in their Opposition, although Acacia cited and relied on these statements in its Motion for Reconsideration (See, Opening Br. at 15:14 – 26 and n 20).

- "***The time encoder makes those data blocks 'addressable' by assigning 'time codes,' which provide offsets from the starting address so that every data block can be individually addressed***. In other words, the information was somehow (the specification does not say how) already placed into a sequence of data blocks before time encoding, and ***the time encoder places it into a sequence of addressable data blocks***." (Round 3 Def's Brief, August 11, 2006, Document No. 198, at 38:23 – 39:3; emphasis added in the first instance; in original in the second instance).

- "After identification/storage encoding (and after processing by conversion means 113), the sequence of data blocks is 'time encoded.' Time encoding 'is achieved by assigning relative time markers to the audio and video data as it passes from the converter 113 through the time encoder 114 to the precompression processor 115.' (8:16-19). ***Although the specification teaches that time encoding makes the sequence of addressable data blocks 'addressable,' the specification is equally clear that time encoding only achieves this result because the starting address where the file will be stored has already been assigned by the identification/storage encoder. That is, the two must be used together***."[28] (Round 3 Def's Brief, August 11, 2006, Document No. 198, at 41:3-10; emphasis added).

- ***"In sum, 'time encoding' relates only to the addressing portion of 'sequence of addressable data blocks.' It makes all of the data blocks, which were already placed into a sequence before time encoding, 'addressable.'*** That is the reason the patent describes 'time encoding' as an 'addressing scheme' (8:1-2) and explains that time encoding 'makes items and subsets of items . . . addressable.' (8:50-53)." (Round 3 Def's Brief, August 11, 2006, Document No. 198, at 42:10-14; emphasis added).

- "***We agree that time encoding is a relative addressing scheme***. For this reason, ***we also agree with Acacia that 'time encoding makes subsets of items addressable' (Acacia Br. p. 78) if the starting location where the data will be stored is known*** as provided for in the storage encoding process performed by the identification encoder." (Round 3 Def's Brief, August 11, 2006, Document No. 198, at 49:9-12).

In other words, the Round 3 defendants' Markman Brief statements support Acacia's request for reconsideration of the construction of "sequence of addressable data blocks." The Court's construction leaves out the requirement of time encoding, which the Round 3 defendants themselves acknowledge is necessary for determining the position of a data blocks relative to the beginning of

[28] Consistent with the Round 3 defendants' statement that time encoding is required to address data blocks, Acacia's expert, Mr. Weiss, testified that there are no addressing schemes disclosed in the patent other than time encoding for addressing data blocks. (Weiss, Sept. 8, 2005, at 168:4-7; Exhibit 2 to Block Decl.)

the file. Thus, the Court's construction should be corrected to make clear that ***both*** the starting position of the file ***and the time codes*** are used together to address the data blocks. Acacia's proposed construction accomplishes this.

B. The Court Should Not Consider the Extrinsic Expert Opinion of Dr. Walters As to the Understanding of Persons of Ordinary Skill in the Art Regarding the Meaning of "Addressable" and "Relative Address"

The Round 3 defendants seek to introduce the expert testimony of Dr. Walters, who testifies in paragraph 40 of his declaration that the "concepts" of "addressing" and "relative addressing" would not be understood by persons of skill in the art to be limited to time codes.[29]

Dr. Walters' testimony is irrelevant to the Court's construction of the phrase "sequence of addressable data blocks." Dr. Walters' so-called opinion relates to what persons of skill in the art would have understood ***apart from the patent*** with respect to "time codes" and addressing data**.** Whether other methods for addressing were known to persons of skill in the art ***apart from the patent*** is irrelevant to how one of ordinary skill in the art would have interpreted the claim term "sequence of addressable data blocks" in light of the intrinsic patent documents and in light of the pertinent case law, as the Court must do when interpreting claims.[30] As demonstrated above, even the Round 3 defendants understood and informed the Court that time encoding is a required part of the addressing scheme taught by the Yurt patents.

Dr. Walters further opines in paragraph 40 of his declaration that the "concept" of

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[29] It is highly unusual for the Round 3 defendants, in ***opposing*** Acacia's motion for reconsideration, to be introducing new expert testimony. Defendants are not offering Dr. Walters' testimony to rebut Acacia's expert's declaration submitted in support of Acacia's motion, because Mr. Weiss did not offer any testimony at all on the issue of "addressable" or the phrase "sequence of addressable data blocks." The time for defendants to have provided such expert testimony was with its Markman Brief, but they did not.

[30] *See Vitronics*, 90 F.3d at 1584 ("[Expert testimony] may not be used to vary or contradict the claim language" or "contradict the import of other parts of the specification."). In *Vitronics*, the court held that the district court erred by considering expert testimony that persons of skill in the art sometimes used the term "solder reflow temperature" interchangeably with "liquidus temperature." The Court stated, in words applicable here, that "[h]owever, regardless of how those skilled in the art would interpret a term in other situations, where those of ordinary skill, on a reading of the patent documents, would conclude that the documents preclude the term from being given the meaning propounded by the expert witnesses, we must give it the meaning indicated by the patentee in the patent claim, specification, and file history." *Id.*, at 1585.

"addressing" could include, but is not limited to, the use of time codes. This opinion is inconsistent with Dr. Walters' opinion that the ordinary meaning of "addressing" is "the starting location of the data in a storage device." (Walters' Decl., ¶¶ 37-38). A starting location in a data storage device ***cannot*** be a time code; it is "the value that represents an individually accessible storage location."[31]

Dr. Walters also opines in paragraph 40 that the "concept" of "relative addressing" could include, but is not limited to, the use of time codes. Nowhere in any intrinsic patent document, including the claims, the specification, or the file history, are the terms "relative address" or "relative addressing" used. Thus, the meaning of these terms is irrelevant to the Court's construction of the term "addressable" in the phrase "sequence of addressable data blocks."

C. The Court Should Decline Defendants' Request for Reconsideration

In their Opposition, the Round 3 defendants ask the Court, under the guise of "clarification" and possible "jury confusion," to reconsider and re-write its construction for "sequence of addressable data blocks." The Court should decline defendants' request for reconsideration, because defendants have neither sought nor obtained leave to file a motion for reconsideration nor filed a motion for reconsideration, as required to pursuant to Local Rule 7-9.

Defendants are asking the Court to re-write its construction in a way that would completely alter what the Court has already found. The Court's construction requires that "addressable" does "not refer to physical storage locations." In other words, the Court found that the patentees used the term "addressable" in the phrase "sequence of addressable data blocks" in a manner inconsistent with its ordinary meaning.

In their reconsideration request in their Opposition, however, the Round 3 defendants ask the Court to re-write its construction such that "addressable" does refer to a storage location: "[a]ddressable does not refer to physical storage locations of each of the individual data blocks, but rather to the ***single known physical storage location*** of the start of the file containing the data blocks and positions of each of the data blocks relative to that known starting storage location."[32] There is no basis for defendants' request, because, as discussed above, the Court correctly found that the patentees used the term "addressable" in the phrase "sequence of addressable data blocks" in a manner inconsistent with its ordinary meaning.[33]

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[31] The Microsoft dictionary definitions for "address" do not include "time codes." According to Microsoft, an address is "the value that represents an individually accessible storage location. In a typical computer, each memory location has a separate address."

IV. THE COURT SHOULD RECONSIDER AND MODIFY ITS CONSTRUCTION FOR "STORING"

A. Acacia's Change in its Proposed Construction of "Storing" Was Prompted by Other Events

That Acacia's position on the meaning of "storing" in the first step of claim 41 has changed is unremarkable, given the opportunities for further reflection and insight provided by the number and variety of arguments faced by Acacia from the different defendant groups in the many briefs, hearings, and Markman orders as the Court has construed and then reconsidered the constructions of terms in the Yurt patents.[34] As the Round 3 defendants state in their opposition, "[t]he Court has sole responsibility for construing the claims, and is not bound by the arguments of any party."

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[32] The Round 3 defendants ***presume*** in their Opposition that Acacia agrees with defendants that the word "addressable" in the phrase "sequence of addressable data blocks" means that the storage location of the start of the file containing the data blocks is known and that the Court intended to incorporate this language in its construction. (Round 3 Def's. Br. at 30:21-27). Acacia does not agree with these statements. The Court's construction specifically states that "addressable" does not refer to physical storage locations and therefore the Court could not have intended to refer to the physical storage location of the start of the file. The Court's reference to "the beginning of a file" is correct.

[33] Defendants appear to be attempting to construe the term "addressable" to have a meaning which they believe to be consistent with the ordinary meaning of "relative address." Besides the fact that the term "relative address" is never used in the claims or patent specification, the Court's construction, which refers to "the beginning of a file" is consistent with the dictionary definition of "relative address" submitted by defendants, which refers to "distance from a starting point." Thus, there is no reason in the ordinary meaning of "relative address" for re-writing the construction as defendants' request.

[34] In this motion alone, relating to just three claim terms (out of the 50 or so terms construed by the Court), Acacia has been able to demonstrate that the Round 1 defendants have changed their position on the construction and definiteness of the term "transmission system." (See, Section II.F. *supra*). Additionally, just from their Markman Brief to their opposition to this motion, the Round 3 defendants have changed their position on whether the patent ever equates addressability of data blocks with time encoding. In their Markman brief, the Round 3 defendants said at least four times that it does, but in their opposition, they said that it does not. (See, Section III.A. *supra*).

(Round 3 Def.'s Opposition, at 20:9-11, citing, *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1556 (Fed. Cir. 1995). Indeed, the Federal Circuit recognizes that courts may engage in a "rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves." *Conoco, Inc. v. Energy & Environmental International L.C.*, 460 F.3d 1349, 1359 (Fed. Cir. 2006)

An historical look at the positions all the parties have taken concerning "storing" is instructive. Acacia's original position was set forth in its Markman brief written in January 2004, when only the Round 1 defendants were involved in the case. Interestingly, at that time, the Round 1 defendants contended that the phrase "storing items having information in a source material library" should not be interpreted to mean "placing," but rather to mean that the items are "readily accessible," i.e., retained, in the source material library:

> The source material library, as demonstrated above, is the organized collection of original source materials that the transmission system converts, compresses, and then transmits. As its name implies and the written description makes clear, it is not simply an off-site library, such as a public library or a video store that bears no relation to the transmission system. Rather, it is the library of original source materials that is available for use by the transmission system, as needed. By necessity, it contains the original source material of the items that have been converted and compressed into the compressed data library, and may contain other materials that might be used by the transmission system at another time, if requested by a user. ***Accordingly, "storing items having information in a source material library" should be interpreted to mean that the transmission system has readily accessible for use original source items of the transmission system in a library***.

(Round 1 Defendants' Claim Construction Brief, January 8, 2004, at 32:19-33:2; Block Supp. Decl. Exhibit 5; *See also,* 1st CCO, at 25:5-9)[35]

When Acacia made its statements in its January 2004 briefs, the state of the case was far different than it is now. At that time, Acacia had understood that the preamble of claim 41 was not

[35] In their opposition brief, however, the Round 1 defendants changed their position to state that "the term 'storing' in claims 1 and 41 should be construed to mean 'to place or leave in a location for later use.'" (Round 1 Defendants' Opposition Claim Construction Brief, January 22, 2004, at 7:24-25; Block Supp. Decl. Exhibit 6.)

limiting. (See, Acacia's Claim Construction Brief, April 17, 2006, at pp. 48-52; Document No. 145 and combined Reply Brief, May 24, 2006, at 38-40, Document No. 173. Subsequently, after June 14, 2006, Acacia recognized that the "performed by a transmission system" language of the preamble was in fact a limitation.

It was this change that prompted Acacia to contend in its July 21, 2006 Brief that "storing" means "adding and maintaining," which Acacia narrowly modified in its August 25, 2006 Brief to mean "adding or maintaining," because (1) the context of the various claims demonstrate that one or the other meanings applies and (2) the change to the disjunctive "or" from the conjunctive "and" was required to conform to the meaning of "store" in the *IEEE Dictionary*, which uses the disjunctive. Additionally, the Court's prior constructions make clear the need to construe "storing" in the disjunctive. In its 3rd CCO, the Court interpreted storing to, in different contexts, mean either "placing" (in claim 41, at 3rd CCO, at 30:4-25 or "holding" (in claim 6 of the '992 patent, at 33, n 12). "Retaining" is simply a synonym for "maintaining," and Acacia regards those words in this context as interchangeable.

Acacia's position in the present motion that the term "storing" be construed to mean "retaining" is not a change from its prior position at all, because Acacia is only seeking reconsideration of the Court's construction of that term in the context of the phrase "storing item having information in a source material library." This is clear from Acacia's proposed order, in which Acacia seeks an order in this motion that: "The phrase 'storing items having information in the source material library' means 'retaining physical items containing audio information or video information or both in a collection of original sources of information." Acacia is not deviating from its position, expressed since August 25, 2006, that storing means "adding or maintaining."

B. There is No Dispute that the Term "Storing" Has Two Alternative Meanings – (1) to Place or (2) to Retain

It is undisputed that, in the *IEEE Dictionary*, the term "store" is defined as having multiple disjunctive meanings:

1. To place data into a device [into which data can be placed, in which they can be retained, and from which they can be retrieved];

2. To retain data in a device [into which data can be placed, in which they can be retained, and from which they can be retrieved]; and

3. To place or retain data in a storage device. (Block Decl., Exh. 3) (See also, (Weiss Decl., at ¶¶ 17-19).

C. It Would Be Legally Proper to Construe "Storing" in the Phrase "Storing Items Having Information in a Source Material Library" to Mean "Retaining"

Defendants contend that the term "retaining" would be an improper method step, because it is not an "act" or "manipulative step;" instead, according to defendants, it is a "passive" step. Defendants rely on Farber, *Landis on Mechanics of Patent Claim Drafting*, § 4.1 (5^{th} Ed. 2006) for the proposition that "the 'elements' of a method claim, instead of being structural parts, are, and must be, acts or manipulative steps that are performed upon an article, workpiece, or chemical substance." *Landis* does not distinguish between "active" and "passive" verbs and defendants do not explain how they have decided that "retaining" is a passive verb, whereas "placing" is an active verb.

In Section 4.2 of *Landis* (not cited by defendants), however, there are listed nine different exemplary method steps demonstrating the grammatical forms of the verbs used. (See, Farber, *Landis on Mechanics of Claim Drafting*, § 4.2 (5^{th} Ed. 2006); Block Supp. Decl. Exhibit 7.) In the ninth example, *Landis* identifies the exemplary method step of "*permitting* the mixture to cool. . ." (*Id.*) Applying *Landis'* statement about the "elements" of a method claim from Section 4.1, we see that the "act or manipulative step" is "permitting" and the article on which the "permitting" act or manipulative step is being performed is "the mixture."

If "permitting" is an "act or manipulative step," then so is "retaining." By looking at the dictionary definitions of these terms, we see that "permitting" is even less of an act than "retaining." The verb "permit" means "to make possible" or "to give an opportunity." (Websters' Third New International Dictionary). That is tantamount to saying "do nothing," which is a non-act. The verb "retain" means "to hold or continue to hold in possession or use." (*Id.*) In the computer and telecommunications art, to which the Yurt patents speak, retaining data for future processing or transmission requires that the data be retained and not lost.

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D. Defendants' Other Contentions are Without Merit

Defendants contend that the preamble requirement that the steps be "performed by the transmission system" require that storing mean something active, not passive, such as "placing" or "adding." (Round 3 Def.'s Opp., at 34:28). For the reasons described above, "retaining" like "placing," is an active verb.

Defendants contend that if "storing" means "retaining," then the first step of the claim would potentially never end and the sequential nature of the steps in the method claim would be lost. (Round 3 Def.'s Opp., at 34:18-35:7). This is absurd, because the steps described in claim 41 describe the particular information being processed and transmitted – not all of the information is in all of the items in the source material library.

Defendants contend that "storing" in claim 41 should be interpreted to have the same meaning as "inputting" in claim 14 of the '863 patent. (Rounds 1 & 2 Def.'s Opp., at 10-11; Round 3 Def.'s Opp., at 36). It should not. "Inputting" has a different meaning and connotation than "storing" in its ordinary meaning and in the context of the claims. The term "storing" does not mean only "placing;" it also connotes being retained after it is placed is being placed.[36] (See, *IEEE Dictonary*: "1. To place data into a device [into which data can be placed, in which they can be retained, and from which they can be retrieved]"). The term "inputting" has no connotation as to whether the item is retained or not. The term "inputting" has a dictionary definition of "the act, process, or an instance of putting in." (Websters' Third New International Dictionary). Indeed, in claim 14 of the '863 patent, nothing in the claim identifies the transmission system component into which the item is being input: "inputting an item having information into the transmission system." Further, unlike claim 41, claim 14 does not require that this step of inputting be "performed by the transmission system."

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[36] The Round 1 defendants stated that the purpose of the "source material library" is to store (retain) items for later use: "The purpose of the source material library of claim 41 and the library means of claim 1 is to store items for 'later use' by the transmission system. ('992 patent at 18:1-3; 20:17-21). For the items to be of later use, they must be readily accessible to the transmission system as needed." (Round 1 Defendants' Opposition Claim Construction Brief, January 22, 2004, at 7:18-22; Block Supp. Decl. Exhibit 6.)

V. CLAIM 45 IS NOT INDEFINITE

A. The Claim 45 Files and Compressed, Sequenced Data Blocks Are Different Than the Claim 41 File and Compressed, Formatted, and Sequenced Data Blocks

Claim 45 adds the step of "separately storing a plurality of files, each including compressed, sequenced data blocks." The parties agree that claim 45 adds this step to the step in claim 41 of "storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code."

The Round 3 defendants contend that claim 45 is indefinite, based on their mischaracterization of claim 45 and of the files and data blocks of claim 45. The Round 3 defendants assume that the claim 45 files and the claim 45 compressed, sequenced data blocks have antecedent basis in the claim 41 file and the claim 41 data blocks.[37] For there to be antecedent basis, however, the word "the" or "said" must precede the words "files" and "compressed, sequenced data blocks" in claim 45; neither of these words appears in claim 45: "separately storing ***a*** plurality of files, each including compressed, sequenced data blocks." From this mischaracterization of claim 45, the Round 3 defendants mischaracterize the method claimed in claim 45 as a method which "processes related data, assigns that data a single unique identification code, and later stores related data in separate files." (Round 3 Def.'s Opposition, at 38:12-14).

The claim 45 files are different from the file created in claim 41, because the files in claim 45 do ***not*** have an antecedent basis to the file in claim 41. The compressed, sequenced data blocks of the files of claim 45 likewise do not have an antecedent basis to the data blocks in claim 41. The claim 45 compressed, sequenced data blocks are in the claim 45 files, i.e., they are not the compressed, formatted, and sequenced data blocks described in claim 41 as being stored in the claim 41 file. Thus, according to claim 45, the claim 41 file is created and stored with its unique identification code. Claim 45 adds the requirement that, separate from the file created and stored in claim 41, a plurality of different files are also stored.

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[37] The Round 3 defendants' mischaracterization of claim 45 is apparent from their addition of the word "the" before the words "compressed, sequenced data blocks" to make it appear as though the compressed, sequenced data blocks of claim 45 are the same as the data blocks of claim 41: "Second, claim 41 requires that the compressed, formatted, and sequenced data blocks be stored in a *single* file, which claim 45, which depends from claim 41, requires that ***the*** compressed, sequenced data blocks be stored in a *plurality* of files." (Round 3 Defendants' Opposition, at 39:12-14; emphasis added to "the").

The method of claim 45 of storing a file having compressed, formatted, and sequenced data blocks with one unique identification code (the claim 41 file) and separately storing additional files having their own compressed sequenced data (the claim 45 files) is not indefinite and is disclosed in the specification, as described in Acacia's opening brief re claim 45 at 1:14-2:7.

B. Claim 45, Unlike Claim 6 of the '992 Patent, Is a Method Claim Which Does Not Require a "Compressed Data Library Means"

In its 3rd CCO, the Court stated that the specification "does not describe storage in multiple files." (3rd CCO, at 33:3-4). Acacia pointed out that the compressed data library 118 does store multiple files.

The Round 3 defendants contend that the Court recognized that the compressed data library stored more than one file, but rejected this structure as support for claim 45, because of the presence of the similar phrase in apparatus claim 6 of the '992 patent: "compressed data library means for separately storing a plurality of files, each including at least one compressed, sequenced data block." In its 3rd CCO, the Court characterized the phrase "separately storing a plurality of files" in claim 6 as an "attribute" of the compressed data storing means 118, which "does not lend itself to conversion to a manipulative step." (3rd CCO, at 33, n 12).

Apparently, the Court, in claim 6, construes the term "storing" to mean "holding," and, if that meaning for storing (holding) is used in claim 45, then the Court believes that the step in claim 45 of "separately storing a plurality of files" would not be a manipulative step. This is wrong for two reasons: (1) the meaning of "storing" in claim 45 is not dictated by claim 6, which, unlike claim 45, is an apparatus claim and this phrase appears as part of a means-plus-function phrase, not as a step in a method claim; and (2) regardless of whether "storing" in claim 45 means "placing" or "holding," as discussed above, both are acts or manipulative steps.[38]

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[38] The Court's focus on the term "manipulative step" is misplaced. The quote from *Landis*, relied upon by the defendants refers to "*acts* or manipulative steps."

The similarity of claim 6 to 45 should only be interpreted to mean that, for the step of claim 45 of "separately storing a plurality of files," the structure described in the specification for performing this step, or the location in which the plurality of files would be stored, would be the compressed data library means (or the compressed data library 118).

Thus, if the step of claim 45 of "separately storing a plurality of files" is an "act or manipulative step," which it is, then the Court should find that claim 45 is definite.

VI. CLAIM 46 IS NOT INDEFINITE

In its 3rd CCO, the Court asked for additional briefing as to when the element of "generating the list of available items" occurs. The Court did not find, nor did it ask the parties to address whether claim 45 was indefinite, had written support, or was enabled. Acacia provided the information requested by the Court and provided an expert declaration stating what persons of ordinary skill in the art would have understood from the claim and the specification as to the when this step would occur.

Only the Round 3 defendants have responded. They state, in footnote 30 on page 40, that one could deduce from the claims themselves that the step of "generating a list of available items" would occur after the claim 41 step of "formatting" but before the steps of "sequencing" and compressing." They contend that this interpretation is correct, because claim 46 refers to "formatted" data blocks, but not to "sequenced" or "compressed" data blocks. Defendants ignore the word "stored" which precedes the word "formatted," making clear that the "formatted" data blocks being retrieved are the "stored compressed, formatted, and sequenced data blocks" which are described in the "storing, as a file" step of claim 41. As Mr. Weiss states, there is no requirement that the generating step occur only after this "storing as a file" step has occurred.

Defendants' other arguments are that claim 46 is indefinite and lacks written support. Claim 46 is not indefinite, anyone skilled in the art would know what is meant by the phrase "generating a list of available items." Whether this claim has sufficient written support is for another day and another motion.

VII. CONCLUSION

For all these reasons and authorities, Acacia's Motion for Reconsideration should be granted.

DATED: August 3, 2007

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